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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/914,823	10/05/2001	Gilles Gutierrez	GEI-088	4121

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EXAMINER

WELLS, LAUREN Q

ART UNIT PAPER NUMBER

1617

DATE MAILED: 03/12/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/914,823

Applicant(s)

GUTIERREZ ET AL.

Examiner

Lauren Q Wells

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 9/3/02, 9/24/02, 1/9/03.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 5-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

Claims 5-15 are pending. The Amendment filed 9/24/02, Paper No. 11, amended claims 5-6, 9-10, 12 and added claims 13-15.

#### ***Response to Arguments***

Applicant's arguments with respect to the 35 USC 102, 103, and 112 rejections over claims 5-15 have been considered but are moot in view of the new ground(s) of rejection.

The objection to the Oath/Declaration in the previous Office Action is maintained. Applicant argues that original declaration is proper. However, this argument is not persuasive. See 37 CFR 1.52(c), wherein it states that alterations to the declaration must be accompanied by initials and a date.

The Amendment filed 1/30/03, Paper No. 13, wherein the abstract is amended, is sufficient to overcome the objection to the specification in the previous Office Action.

#### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5-15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(i) Claim 12 is vague and indefinite, as it is confusing. What is the method step? Is it applying the maturation of keratinocytes or is it applying on the body, a cosmetic? How can one apply the maturation of keratinocytes? How is skin endowed with a better quality of resistance?

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What is meant by this? What is an active extract? What differentiates an active extract from an inactive extract?

(ii) Claim 5 recites the limitation "of claim 4". There is insufficient antecedent basis for this limitation in the claim.

(iii) The phrase "a support or vehicle appropriate for topical preparations in an oily phase, or dry" in claim 5 is vague and indefinite, as it is confusing. Is the support or vehicle in an oily phase? Is the support or vehicle an oily phase? What is meant by "dry"? How does the term "dry" relate to the rest of the claim?

(iv) Claim 6 recites the limitation "of claim 3". There is insufficient antecedent basis for this limitation in the claim.

(v) The phrase "in which a silicone oil is added to the solution by produce a fluid emulsion" in claim 6 is vague and indefinite, as it is confusing. What does this phrase mean?

(vi) The concentration recited in claim 9 is vague and indefinite, as it is not clear to what it is referring. Per liter of what?

(vii) Claim 10 recites the limitation "of claim 3". There is insufficient antecedent basis for this limitation in the claim.

(viii) Claim 10 is vague and indefinite, as it is confusing. What are "Unites"? What are unites of activity per kg of active principle on a support per kg of final topical composition? What type of unit of measurement is this? What is a support? What is active principle? Active principle and support lack antecedent basis.

(ix) Claim 13 is vague and indefinite, as it is confusing. What does it mean that a culture media is further used?

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(x) Claims 8-9 recite the limitation "the active principle". There is insufficient antecedent basis for this limitation in the claim.

(xi) Claim 11 is vague and indefinite, as it is confusing. What is this claim referring to? What does it mean?

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11-13 rejected under 35 U.S.C. 102(b) as being anticipated by “Synthesis from the Sea”.

“Synthesis from the Sea” discloses that the use of cosmetic formulations containing 2-5% of an extract of *Padina pavonica* helps protect the skin against free radicals and other irritation. As a skin cosmetic, this disclosure implies the topical application of compositions containing a *Padina pavonica* extract. See entire disclosure.

Since the instant invention exemplifies an extract of *padina pavonica* as comprising 1-10% of a cosmetic formulation, the disclosure of 2-5% in “Synthesis from the Sea” meets the limitation of “*Padina pavonica* effective to effect said amplification”.

Since “Synthesis from the Sea” teaches applying the same composition in the same effective amount to the skin, the composition of “Synthesis from the Sea” must have the property of endowing skin with better quality of resistance. Furthermore, the Examiner respectfully points out that the claims are directed to a method of applying a composition comprising an

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effective amount of an extract of *Padina pavonica* to the skin. Any properties exhibited by or benefits provided the composition are inherent and are not given patentable weight over the prior art. A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the properties Applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ 1655, 1658 (Fed. Cir. 1990). See MPEP 2112.01. The burden is shifted to Applicant to show that the prior art product does not inherently possess the same properties as instantly claimed product. The prior art teaches application to the skin of compositions containing the same components as instantly claimed, which would inherently endow skin with better quality of resistance as instantly claimed. Applicant has not provided any evidence of record to show that the prior art compositions do not exhibit the same properties as instantly claimed. Furthermore, the Examiner respectfully points out that the instant claims are ultimately useful for treating skin aging, and that "Synthesis of the Sea" is directed toward treating skin aging.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 7-10, 14-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Synthesis from the Sea" as applied to claims 11-13 above.

"Synthesis from the Sea" is applied as discussed above. The reference does not teach preferred amounts of the extract.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to exemplify the instant claimed amounts of *padina pavonica* since the “Synthesis” discloses the same percent weight of the extract in cosmetic compositions as the effective amount of the instant invention, and it would have been obvious since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Claims 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over “Synthesis from the Sea” as applied to claims 11-13 above, and further in view of Gutierrez (5,961,981).

“Synthesis from the Sea” is applied as discussed above. The reference does not teach specific ingredients of the cosmetic formulation.

Gutierrez teaches topical application of cosmetic compositions containing an extract obtained from a algae of the family Dictyotales (title, abstract, Col. 1, lines 21-34, Col. 5, lines 40-44, Col. 6, lines 64-66 and the examples at Col. 13, lines 33-46). *Padina pavonica* is taught as a species of Dictyotales. For dispersion or incorporation of the extract onto a support or vehicle see column 5, lines 11-13 and the examples at column 11 and column 13. For polyethylene glycol see column 2, lines 45-46. For silicone fluid emulsions see column 12, line 64 to column 13, line 4.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the cosmetic formulation discloses by “Synthesis” as that taught by Gutierrez because of the expectation of achieving a cosmetic formulation wherein *padina pavonica* extract maintains its biological activity.

Claims 5-6 and 10 are recited as depending on claims 4 and 3, respectively. However, since claims 4 and 3 are cancelled, the Examiner examined these claims as if they were dependent on claim 12.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lauren Q Wells whose telephone number is (703) 305-1878. The examiner can normally be reached on M-F (7-5:30), with alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on (703)305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.



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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1234.

lqw  
March 6, 2003



SREENI PADMANABHAN  
PRIMARY EXAMINER

3/9/03